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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389 7590 09/17/2010 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PHAN, HUY Q				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/589,217

Applicant(s)

COOPER, DAVID

Examiner

HUY PHAN

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on date: 08/02/2010.

Claims 28, 29, 32 and 33-38 are still pending.

Claims 34-38 are newly added.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argued that "the cited references fail to teach or even suggest each and every limitation of the claims... Notably, none of the cited references teach or suggest at least the limitations of receiving a message on said user equipment including a first list including a plurality of network identifiers corresponding to a plurality of available networks for a potential handover, said receiving from a current active communication network while a call is in progress and said receiving of said message occurs without said user equipment searching any communication network, as recited in the claims". Even though the applicant has amended the independent claims and it is still found that Lynch discloses the dispute limitation of the claims such as receiving a message on said user equipment including a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), said receiving from a current active communication network while a call is in progress

("complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46) and said receiving of said message occurs without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46). Note: this is a new ground of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28, 29 and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Lynch (US 5,761,618; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 7, 101) for a mobile communication system (fig. 7 and col. 13, lines 21-37) comprising:

receiving a message on said user equipment including a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks available for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), said receiving from a current active communication network while a call is in progress ("complete a call to the mobile subscriber unit,

informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46); and

selecting one network of the plurality of available networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment ("The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5),

wherein said current active communication network signals one or more of the plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 29, Lynch discloses User equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

means for receiving a message that includes a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), from a current active the communication network while a call is in progress

("complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46); and

means for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment ("The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5), wherein said current active communication network signals one or more of the plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 33, Lynch discloses user equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

a receiver for receiving a message that includes a first list of a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), from a current active communication network while a call is in progress ("complete a call

to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46); and

a selector for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment ("The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5) wherein said current active communication network signals one or more of the plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), and said receiver receives said message without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 34, Lynch discloses the method for user equipment for a mobile communication system according to claim 28, wherein said message is a dedicated message ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) for signaling available networks for handover ("complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46).

Regarding claim 35, Lynch discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message is periodically transmitted by said current active network without a specific request ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 36, Lynch discloses the method for user equipment for a mobile communication system according to claim 28, further comprising the step of: storing said first list in said user equipment ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46).

Regarding claim 37, Lynch discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message includes a special identifier indicating that said message contains a list of available networks for handover ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 38, Lynch discloses the method for user equipment for a mobile communication system according to claim 36, further comprising the step of: receiving, by the user equipment, a second message including at least one network identifier corresponding to a network that is to be deleted from the first list ("set to "zero" for a deletion from the SID list stored in the mobile subscriber unit" see col. 16, lines 21-46).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Daly (US 6,122,503; previously cited) and further in view of I (US 6,088,335; newly cited).

Regarding claim 32, Lynch discloses a mobile communications network or component (fig. 7 and col. 13, lines 21-37) thereof including:

means for receiving by a user equipment (fig. 7, 101) a message that includes a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), from a current active communication network while a call is in progress ("complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46);

means for selecting one network of a plurality of networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment ("The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5);

means for receiving from user equipment communicating with the current active network an indication of a preferred other network ("a mobile subscriber unit sends a code" see col. 16, lines 21-46); and

wherein said current active communication network signals one or more of the plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

But, Lynch does not particularly show said second list including at least one network identifier corresponding to a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying neighboring cell information for the preferred other network based on the indication. However in

analogous art, I teaches means for supplying neighboring cell information for the preferred other network based on the indication ("base stations of cells in its neighbor list... indicate to the base station (e.g., BS1) the interference levels that that mobile would generate at neighboring base stations (e.g., BS2)" see col. 7, lines 44-63); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Daly as taught by I for purpose of providing the future cell information which would helps the handoff process more reliable and efficient.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mattila discloses that "The MSC controls the paging of a mobile station believed to be in the geographic area served by its base stations B1-B10 in response to the receipt of a call for that mobile station, the assignment of radio channels to a mobile station by a base station upon receipt of a page response from the mobile station, as well as the handoff communications with a mobile station from one base station to another in response to the mobile station traveling through the system, from cell to cell, while communication is in progress" (see specification).

Feuerstein discloses that "network parameters include network wide parameters such as communication thresholds, e.g., a threshold at which a signal strength handoff

might be requested. Likewise, the network parameters include network timing information, such as search windows. Additionally, network parameters may include information localized to a particular portion of the communication network. Such localized network parameters include individual cell, sector or beam traffic density, or related capacity parameters, and neighboring cell lists" (see specification).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY PHAN whose telephone number is 571-272-7924. The examiner can normally be reached on 9AM-730PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/
Primary Examiner, Art Unit 2617
Date : 03/26/2010